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Application No. 10/662,785

REMARKS

Applicant wishes that thank the examiner for the courtesy of the interview conducted with Applicant's attorney last week.

Claim Rejections – 35 USC § 112

Applicant has amended claim 25 to return it to its original form "mixing" so that the rejection under 35 USC 112, first paragraph is overcome and should be withdrawn.

Claim Rejections – 35 USC § 103

Claims 25-32 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,827, 494 to Yano ("Yano") in view of U.S. Patent No. 4,297,249 to Przybyla ("Przybyla") and claims 32-40 are rejected under 35 USC 103(a) as being unpatentable over Yano in view of Przybyla, and further in view of U.S. Patent No. 4,146,685 to Tucholski ("Tucholski") and U.S. Patent No. 5,688,616 to Yamawaki ("Yamawaki"). Applicant traverses these rejections because the examiner has not established a *prima facie* case of obviousness for the reasons set forth below and the rejections are improper and shown be withdrawn.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference must teach or suggest all the claim limitations. *See MPEP. § 2143*. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In the present case, the examiner has not shown the motivation/suggestion to combine the prior art and therefore the rejection is improper and should be withdrawn.

Yano and Przybyla

In the final rejection, the examiner stated "Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the electrode mix of Yano with the alkali metal salt of a fatty acid and graphite to aid in the lubrication of the powder as it is formed, which promotes a more consistent and uniform density to the electrode" *See Final Office action at pg. 3*. However, the examiner has not shown the required suggestion

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or motivation to combine the prior art to disclose the claimed invention because Yano and Przybyla are non-analogous prior art because they are not in the field of endeavor of the applicant and are not reasonably pertinent to the particular problem with which the invention is concerned and therefore cannot be used as prior art to reject the claims of the present application. *See MPEP 2141.01(a)*.

First, neither Yano nor Przybyla is in the field of applicant's endeavor (making a zinc electrode composition with low shape change and an absence of dendrite growth at high charge and discharge rates) since Yano is directed to making a nickel electrode (see Yano, col. 5, line 48) and Przybyla is directed to preparing a silver oxide electrode (Przybyla, claim 1). Second, because Yano and Przybyla are in a different field of endeavor, they are not reasonably pertinent to the particular problem with which the invention is concerned. In particular, the cited prior art is attempting to resolve the problem of a more consistent and uniform density of a silver oxide electrode of Przybyla. In contrast, the problem addressed by the claimed invention is making zinc electrodes with low shape change and an absence of dendrite growth at high charge and discharge rates. Therefore, Yano and Przybyla are not reasonable pertinent to the particular problem with which the invention is concerned.

Furthermore, there is no motivation/suggestion to combine Yano with Przybyla because one of ordinary skill in the art would not combine Yano (directed to making a nickel electrode) with Przybyla (directed to making a silver oxide electrode) in order to find a method for making a zinc electrode composition that has a unique problem not addressed or even suggested by Yano or Przybyla. Furthermore, neither Yano nor Przybyla discloses a zinc electrode nor a method for making a zinc electrode. Therefore, claim 25-32 are not obvious over Yano in combination with Przybyla.

Yano, Przybyla, Tucholski and Yamawaki

Tucholski and Yamawaki (the other prior art relied on by the examiner) do not cure the deficiencies noted above for Yano and Przybyla. Therefore, claims 32-40 are also allowable over the prior art and should be allowed.

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Conclusion

Based on the above, Claims 25-40 are now in condition for allowance. Please feel free to contact the undersigned attorney at (650) 833-2055 if a telephone conversation would be useful to expedite the prosecution of this case.

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees to Deposit Account No. 07-1896 referencing Docket No. 358261-991100 (formerly 1772-000002). A duplicate copy of this paper is enclosed.

Respectfully submitted,

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